

REMARKS

Claims 1, 3-30 and 33-42 are pending. Claims 2, 31 and 32 are canceled.

CLAIM REJECTIONS - 35 U.S.C. § 112

The instant Office Action states that Claims 1, 3-30 and 33-42 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the instant Office Action states:

Claims 1 and 30 add the limitations of "selecting one of said plurality of carrier entries based on an attribute of said demand entry and automatically booking said selected carrier entry in response to said demand entry" which lacks support in the original specification.

See the instant Office Action, page 2, section 3.

Applicants respectfully disagree with this interpretation of the above-identified patent application. Indeed, Applicants respectfully assert that the features "selecting one of said plurality of carrier entries based on an attribute of said demand entry; and automatically booking said selected carrier entry in response to said demand entry", as recited in independent Claim 30, and similarly independent Claim 1, are disclosed at least at page 4, line 29 – page 5, line 6, page 7, lines 14-28, page 11, lines 15-18, and page 14, line 27 – page 15, line 3 of the above-identified patent application, as filed.

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

I. Hunt in view of Williams

The instant Office Action states that Claims 1, 3, 4, 6-19, 26-28, 30, 33, 35 and 37-39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunt et al. (U.S. Patent No. 5,835,716; hereinafter "Hunt") in view of Williams et al. (U.S. Patent No. 6,560,509; hereinafter "Williams").

Applicants respectfully point out that the instant Office Action presents arguments for rejecting Claims 5, 31, 32 and 34, yet fails to formally reject to these claims under 35 U.S.C. § 103(a). See the instant Office Action, page 4, section 6 and page 8, section 28. Nevertheless, Applicants have reviewed the above-cited art and respectfully submit that the embodiments as recited in Claims 1, 3, 4, 6-19, 26-28, 30, 33, 35 and 37-39, as well as in Claims 5, 31, 32 and 34, are patentable over Hunt in view of Williams for at least the following rationale.

A. Claims 1, 3, 4, 6-19, 26-28, 30-33, 35 and 37-39

Independent Claim 30, and similarly independent Claim 1, recites the features (emphasis added):

A method comprising:

...

selecting one of said plurality of carrier entries based on an attribute of said demand entry; and
automatically booking said selected carrier entry in response to said demand entry.

Applicants understand Hunt to teach:

The system operator selects an appropriate matched entry which must then be confirmed. Upon confirmation, selected matches are saved to a transaction database and assigned a transaction code.

Abstract of Hunt (emphasis added). Applicants understand Williams to teach

“[t]he particular order may be automatically assigned to a carrier” Abstract of Williams (emphasis added).

The instant Office Action states:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of selecting and booking a carrier of Hunt, to be automated as disclosed as Williams, because the use of known techniques of automating the selection and booking of a carrier would have been obvious to one of ordinary skill in the art.

See the instant Office Action, page 5, section 8.

Applicants respectfully submit that “[i]t is improper to combine references where the references teach away from their combination.” MPEP § 2145(X)(D)(2) (emphasis added), citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). Applicants respectfully note that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP § 2141.02(VI) (emphasis in original), citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Assuming arguendo that Williams teaches or suggests “selecting one of said plurality of carrier entries based on an attribute of said demand entry; and automatically booking said selected carrier entry in response to said demand entry”, as claimed (emphasis added), Applicants nevertheless respectfully submit that there is no motivation to modify Hunt in view of Williams at least because Hunt teaches away from the suggested modification.

In particular, Applicants respectfully submit that the requirement of Hunt that, subsequent to selection of “an appropriate matched entry”, the selected entry “must then be confirmed” (Abstract of Hunt (emphasis added)) teaches away from the modification of automatically booking a selected entry. Indeed, Applicants respectfully submit that a process of automatically booking a selected entry necessarily precludes execution of the step of receiving confirmation of a selected entry, as required by Hunt.

For at least the foregoing rationale, Applicants respectfully submit that Claim 30, and similarly Claim 1, is not unpatentable over Hunt in view of Williams under 35 U.S.C. § 103(a). As such, allowance of Claims 1 and 30 is respectfully requested.

With respect to Claims 3, 4, 6-19 and 26-28, Applicants respectfully point out that Claims 3, 4, 6-19 and 26-28 depend from allowable independent Claim 1, and recite further features. With respect to Claims 31-33, 35 and 37-39,

Applicants respectfully point out that Claims 31-33, 35 and 37-39 depend from allowable independent Claim 30, and recite further features. Therefore, Applicants respectfully submit that Claims 3, 4, 6-19, 26-28, 31-33, 35 and 37-39 overcome the rejections under 35 U.S.C. § 103(a), and that these claims are thus in a condition for allowance as being dependent on an allowable base claim. As such, allowance of Claims 3, 4, 6-19, 26-28, 31-33, 35 and 37-39 is respectfully requested.

B. Claims 5 and 34

As stated above, the instant Office Action presents arguments for rejecting Claims 5 and 34, yet fails to formally reject these claims under 35 U.S.C. § 103(a). Nevertheless, Applicants have reviewed the above-cited art and respectfully submit that the embodiments as recited in Claims 5 and 34 are patentable over Hunt in view of Williams for at least the following rationale.

i. Dependency on Allowable Base Claim

With respect to Claim 5, Applicants respectfully point out that Claim 5 depends from allowable independent Claim 1, and recites further features. With respect to Claim 34, Applicants respectfully point out that Claim 34 depends from allowable independent Claim 30, and recites further features. Therefore, Applicants respectfully submit that Claims 5 and 34 overcome the rejections under 35 U.S.C. § 103(a), and that these claims are thus in a condition for allowance as being dependent on an allowable base claim. As such, allowance

of Claims 5 and 34 is respectfully requested.

ii. Unsupported Official Notice

The foregoing notwithstanding, the instant Office Action states:

Hunt ... fails to disclose the logic unit allows a user to define a subgroup within the exchange system, and assign unrestricted access to only members of the subgroup. The examiner takes official notice that the use of defining a group who has unrestricted access to the system is old and well known in the art.

See the instant Office Action, page 8, section 28 (emphasis added).

Applicants respectfully submit that the instant Office Action has provided inadequate support of a finding of Official Notice. The “assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support.” MPEP § 2144.03(A), citing *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Indeed, “[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.” MPEP § 2144.03(E), citing *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 421 (CCPA 1970)).

Applicants respectfully submit that the embodiment of Claim 5 (“said logic unit allows a user to define a subgroup within said exchange system and to limit unrestricted access of at least a portion of said database only to members of said

subgroup”), and similarly the embodiment of Claim 34 (“allowing a user to define a subgroup of shippers and carriers and granting unrestricted access to said database only to said subgroup”), is not considered to be old and well known in the art, as asserted in the instant Office Action. Furthermore, Applicants respectfully submit that the basis for Official Notice, as relied on in the instant Office Action, is not set forth explicitly, as required. Indeed, Applicants respectfully assert that the instant Office Action has taken Official Notice without providing a clear and unmistakable technical line of reasoning, as required.

Thus, Applicants respectfully submit that the instant Office Action does not explain why the specific embodiments recited in Claims 5 and 34 are common knowledge, or how the presented teachings relate to the claims. Accordingly, Applicants respectfully request that the Examiner provide adequate evidence in the form of an affidavit in support of the finding of Official Notice, in accordance with 37 CFR § 1.104(d)(2).

II. Hunt in view of Williams and in further view of Nel

The instant Office Action states that Claims 20-25, 29, 36 and 40-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hunt in view of Williams, and in further view of Nel (U.S. Patent Application Publication No. 2003/0036935). Applicants have reviewed the above-cited art and respectfully submit that the embodiments as recited in Claims 20-25, 29, 36 and 40-42 are

patentable over Hunt in view of Williams, and in further view of Nel, for at least the following rationale.

Claims 20-25 and 29 are dependent on independent Claim 1 and include the features of Claim 1. Claims 36 and 40-42 are dependent on independent Claim 30 and include the features of Claim 30. Hence, by demonstrating that Hunt in view of Williams, and in further view of Nel, does not teach or suggest the features of Claims 1 and 30, it is also demonstrated that Hunt in view of Williams, and in further view of Nel, does not teach or suggest the embodiments of Claims 20-25, 29, 36 and 40-42.

Independent Claim 30, and similarly independent Claim 1, recites the features (emphasis added):

A method comprising:

...

selecting one of said plurality of carrier entries based on an attribute of said demand entry; and
automatically booking said selected carrier entry in response to said demand entry.

As stated above, Applicants respectfully submit that there is no motivation to modify Hunt in view of Williams at least because Hunt teaches away from the suggested modification. Similarly, assuming arguendo that Williams teaches or suggests “selecting one of said plurality of carrier entries based on an attribute of said demand entry; and automatically booking said selected carrier entry in response to said demand entry”, as claimed, Applicants nevertheless respectfully

submit that there is no motivation to modify Hunt in view of Williams, and in further view of Nel, at least because Hunt teaches away from the suggested modification of automatically booking a selected entry.

For at least the foregoing rationale, Applicants respectfully submit that Claim 30, and similarly Claim 1, is not unpatentable over Hunt in view of Williams, and in further view of Nel, under 35 U.S.C. § 103(a).

With respect to Claims 20-25 and 29, Applicants respectfully point out that Claims 20-25 and 29 depend from allowable independent Claim 1, and recite further features. With respect to Claims 36 and 40-42, Applicants respectfully point out that Claims 36 and 40-42 depend from allowable independent Claim 30, and recite further features. Therefore, Applicants respectfully submit that Claims 20-25, 29, 36 and 40-42 overcome the rejections under 35 U.S.C. § 103(a), and that these claims are thus in a condition for allowance as being dependent on an allowable base claim. As such, allowance of Claims 20-25, 29, 36 and 40-42 is respectfully requested.

CONCLUSION

In light of the above-listed remarks, reconsideration of the rejected claims is requested. Based on the arguments presented above, it is respectfully submitted that Claims 1, 3-30 and 33-42 overcome the rejections of record. Therefore, allowance of Claims 1, 3-30 and 33-42 is respectfully solicited.

Should the Examiner have a question regarding the instant response, the Applicants invite the Examiner to contact the Applicants' undersigned representative at the below-listed telephone number.

Respectfully submitted,
WAGNER BLECHER LLP

Date: 5/15/08



John P. Wagner, Jr.
Reg. No. 35,398

WESTRIDGE BUSINESS PARK
123 WESTRIDGE DRIVE
WATSONVILLE, CALIFORNIA 95076
(408) 377-0500